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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,414	01/28/1999	JAMES S. UMSTETTER	99P744US	6061

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

TRAN, CON P

ART UNIT	PAPER NUMBER
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2644

13

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,414

Applicant(s)

UMSTETTER ET AL.

Examiner

Con P. Tran

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8,9,17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,9,17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3, 5-9, 17, and 19-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Bentley et al. U.S. Patent 5,727,047 (hereinafter, "Bentley").

Regarding **claim 1**, Bentley teaches a method for extending capability of a telephone (see Fig. 1, 2, 3, 4, and respective portions of the specification) comprising steps of:

enabling a telephone (300, Fig. 1, col. 2, line 65 – col. 3, line 8; standby mode) to store call-related data in memory located within the telephone (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

enabling a computer (110, Fig. 1, col. 2, line 65 – col. 3, line 8; powered-on, col. 4, lines 14-20) to alternately store the call-related data in memory located within the computer (see col. 27, lines 8-17);

receiving first call-related data at the telephone (i.e., checks for call identification information, see col. 11, lines 51-59);

recognizing that the first call-related data is to be stored in memory (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

determining, within the telephone, whether the first call-related data will be stored in the telephone memory or the computer memory (see Fig. 4; col. 27, lines 8-17); and

storing the first call-related data in the telephone memory or the computer memory based upon the determination (see Fig. 4; col. 27, lines 8-17);

enabling a first processor (call ID decoder and sniff circuit 112) located within the telephone to process data received at the telephone (col. 3, lines 22-26; stored in the Call Log; see col. 11, lines 51-59);

enabling a second processor inherently located within the computer to process (e.g., upload, download) data received at the telephone (col. 4, lines 21-29);

recognizing that the first call-related data received at the telephone is to be processed (e.g., stored; see col. 11, lines 51-59) in order to provide a particular telephone function (deleting oldest entry for redialing, col. 18, lines 23-28); and

determining, within the telephone, whether the first call-related data (call ID information) will be processed (e.g., transferred, stored) by the first processor or the second processor (col. 4, lines 21-29; col. 27, lines 8-17), including at least partially basing the determining upon whether the telephone has the processing capability to provide the particular telephone function (if the maximum number of entries is exceeded, deleting oldest entry for redialing, col. 18, lines 23-28), the telephone thereby controlling the first call-related data (call ID information) to which of two

structurally separate components (telephone 300 or computer 110; Fig. 1) will perform processing thereon (col. 4, lines 18-35).

wherein the telephone is enabled to perform telephone functions independently of the computer (col. 2, lines 10-14; col. 27, lines 18-22), but is reliant upon cooperation with the computer in performing the particular telephone function (call ID information can be uploaded or downloaded from computer, col. 4, lines 21-29).

Regarding **claim 2**, Bentley further teaches a step of establishing a direct data connection between the telephone (through RS-232) and the computer and the computer being structurally separate components (Fig. 1 and respective portions of the specification; col. 4, lines 18-35; col. 27, lines 17-22).

Regarding **claim 3**, Bentley further teaches the method as claimed in claim 2 wherein the telephone (300) and the computer (110) are located within a common workspace, the step of establishing the direct data connection (e.g., for transferring call ID information) being independent of providing connectivity for receiving the first call-related data (see Fig. 1 and respective portions of the specification; col. 2, lines 10-14; col. 27, lines 17-22).

Regarding **claim 5**, Bentley further teaches a method as claimed in claim 1 wherein the step of determining includes steps of:

monitoring storage availability within the telephone memory; comparing the monitored storage availability to a storage threshold that is related to the telephone memory (i.e. 50% full; first step of Fig. 4); and storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded (i.e., if memory on the telephone is greater than 50% full then transfer; Fig. 4; col. 2, lines 10-14; col. 27, lines 18-22).

Regarding **claim 6**, Bentley further teaches a step of retrieving call-related data (i.e., download call ID information) from the computer to the telephone in response to signals from the telephone (see col. 4, lines 21-29).

Regarding **claim 8**, Bentley teaches the method as claimed in claim 1 further including a step of utilizing a processor of the computer to process (i.e., transfer) at least a portion of the first call-related data in response to instructions from the telephone (col. 4, lines 21-29; col. 27, lines 8-17).

Regarding **claim 9**, Bentley further teaches a step of establishing a data connection between the telephone (300) and the computer (110) by connecting the telephone separately to a telephone network (through RJ-11) and to the computer (through RS-232; Fig. 1 and respective portions of the specification; col. 2, line 65 – col. 3, line 8; col. 27, lines 17-22).

Regarding **claim 17**, Bentley teaches a method for extending a telephone's capability (see Fig. 1, 2, 3, 4, and respective portions of the specification) comprising steps of:

enabling a first processor (call ID decoder and sniff circuit 112) resident in the telephone to process data received at the telephone (col. 3, lines 22-26; stored in the Call Log; see col. 11, lines 51-59);

enabling a second processor inherently resident in the computer to process (e.g., upload, download) data received at the telephone (col. 4, lines 21-29);

establishing a direct data connection between the telephone (through RS-232, Fig. 1; col. 2, line 65 – col. 3, line 8), wherein and the computer and the computer being structurally separate components located within a common workspace (col. 4, lines 18-35) and wherein the telephone is configured to perform telephone functions independently of the telephone (col. 2, lines 10-14; col. 27, lines 17-22);

receiving call-related data at the telephone (i.e., checks for call identification information, see col. 11, lines 51-59);

recognizing that the first call-related data required further processing (i.e. 50% full; first step of Fig. 4; col. 27, lines 17-22);

determining, using automated processing capabilities of the telephone processing (i.e. 50% full; first step of Fig. 4), whether the call-related data will be processed in the first processor (of telephone) or the second processor (of computer), including basing said determination upon automated processing performed by the

telephone (i.e., if memory on the telephone is greater than 50% full then transfer; Fig. 4; col. 2, lines 10-14; col. 27, lines 18-22); and

processing the call-related data in either the telephone or the computer based upon the determination made using the automated capabilities (i.e., if memory on the telephone is greater than 50% full then transfer; Fig. 4; col. 2, lines 10-14; col. 27, lines 18-22).

Regarding **claim 19**, Bentley further teaches a method as claimed in claim 17 (see Fig. 1, 2, 3, 4, and respective portions of the specification) including steps of:

enabling a telephone (300, Fig. 1, col. 2, line 65 – col. 3, line 8; standby mode) to store data received at the telephone in memory located within the telephone (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

enabling a computer (110, Fig. 1, col. 2, line 65 – col. 3, line 8; powered-on, col. 4, lines 14-20) to store data received at the telephone in memory located within the computer (see col. 27, lines 8-17);

recognizing that the received call-related data is to be stored in memory (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

determining, within the telephone, whether the call-related data will be stored in the telephone memory or the computer memory (see Fig. 4; col. 27, lines 8-17); and

storing the call-related data in the telephone memory or the computer memory based upon the determination (see Fig. 4; col. 27, lines 8-17);

Regarding **claim 20**, Bentley further teaches the steps of determining are performed by an application programming interface residing within the telephone (see flow chart of Figure 4 through Figure 7; col. 2, lines 55-58; col. 4, lines 38-52).

Regarding **claim 21**, Bentley further teaches method as claimed in claim 17 wherein the steps of receiving (a call), recognizing (caller ID), determining (if redial stack is full) and processing (deleting oldest number) all occur during a single telephone call in which the call-related data is received (col. 18, lines 20-35).

Response to Amendment

3. With respect to objection of **claim 1**, the correction has been made. Accordingly, the objection is withdrawn.

Response to Arguments

4. Applicant's arguments with respect to claims 1-3, 5-6, 8-9 have been considered but are moot in view of the new grounds of rejection.

5. Applicant's arguments with respect to claims 17, and 19-20 have been fully considered but they are not persuasive.

Applicant further asserts on page 10:

“ . . . the Bentley et al. method does not proceed to a step of determining whether the call-related data will be processed in the first processor of the telephone or the second processor of the computer. . . ”

Examiner respectfully disagrees. The first step of Fig. 4, “recognizing step”, and the second step “Is computer in powered-on state?” inherently constitute step of determining whether the call-related data will be processed in the first processor of the telephone (NO branch, i.e., memory of the telephone is less than 50% full) or the second processor of the computer (YES branch, i.e., memory of the telephone is greater than 50% full, and computer is in powered-on state).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

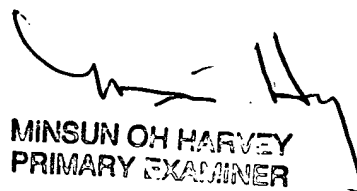
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran, whose telephone number is (703) 305-2341. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office at telephone number (703) 306-0377.

cpt CPJ
April 5, 2004


MINSUN OH HARVEY
PRIMARY EXAMINER